All communications respecting this case should identify it by number and names of parties.

Paper No. 30

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Applicants: Bouchard et al.
Application: 08/162,984
Filed: 12/08/93
Title: NEW TAXIODS, THEIR PREPARATION AND PHARMACEUTICAL COMPOSITION CONTAINING THEM
Accorded benefit: France 92 14813, filed 12/09/92

REDECLARATION

The primary examiner has requested that another interference be declared between the Chen et al. patent 4,254,580 and a third party, Hester et al. application, Serial No. 08/454,210. Upon review by the APJ, it is clear that the third party, Hester et al., claims the same patentable invention as that of count 1 in this interference. Further, after consulting with the primary examiner it appears that Hester et al. may have support for counts 2 and/or 3, and thus, the examiner has recommended that the Hester et al. application be added to this proceeding.

Accordingly, the APJ pursuant to 37 CFR § 1.642 will redeclare this interference to add the Hester application, Serial No. 08/454,210, to this interference. However, in order to resolve the issue of whether Hester et al. can participate as to counts 2 and/or 3, the undersigned sets forth **A 30 DAY PERIOD FOR HESTER ET AL.** to file an amendment containing claims directly to counts 2 and/or 3. If it is determined that

Hester et al. cannot or declines to present claims which define the same patentable invention(s) as that of counts 2 and/or 3, the present interference will be bifurcated with respect to the counts. In re Redeclaration of Interferences, 1926 C.D. 75. Each party must be involved on every count.

After a determination is made with respect to Hester et al. application and counts 2 and 3, an order will issue providing a restricted motion period for parties Chen et al. and Bouchard et al., limited to the bringing of such motions as could not have been previously brought, i.e., any motion which they might have filed had the Hester et al. application been part of the interference at the time preliminary motions were originally filed.

Accordingly, the Administrative Patent Judge (APJ), pursuant to 37 CFR § 1.642, redeclares Interference No. 103,675 by adding the Hester et al. application to this proceeding as follows:

Junior Party

Patentees:	SHU-HUI CHEN 55 Greens Ridge Road Hamden, CT 06514 VITTORIO FARINA 54 Sedgwick Road West Hartford, CT 06107
Application:	08/029,819, filed March 11, 1993, now Patent No. 5,254,580, granted October 19, 1993
Title:	7, 8-CYCLOPROPATAXANES

Serial No. 08/162,984

Assignee:	Bristol-Myers Squibb Company
Attorneys:	Aldo A. Algieri, Samuel J. DuBoff, William T. Han, Michelle A. Kaye, David M. Morse, Sandra M. Nolan, Richard P. Ryan, Mollie M. Yang, Pradbodh Almaula and Frank P. Hoffman
Asso. Attorneys:	Joseph M. Fitzpatrick, Lawrence F. Scinto, William J. Brunet, Robert L. Baechtold, John A. O'Brien, John A. Krause, Henry J. Renk, Peter Saxon, Antony M. Zupcic, Charles P. Baker, Stevan J. Bosses, Edward E. Vassallo, Ronald A. Clayton, Lawrence A. Stahl, Laura A. Bauer, Leonard P. Diana, David M. Quinlan, Nicholas N. Kallas, William M. Wannisky, Lawrence Alaburda, Lawrence S. Perry, Robert H. Fischer, Christopher Philip Wrist, Gary M. Jacobs, Michael K. O'Neill, Bruce C. Haas, Scott K. Reed, Scott D. Malpede, John A. Mitchell, Fredrick M. Zullow, Richard P. Bauer, Warren E. Olsen, Abigail F. Cousins, Steven E. Warner, Thomas J. O'Connell, Aaron C. Deditch, Penina Wollman, David L. Schaeffer, Jack S. Cubert, Mark A. Williamson, John T. Whelan, Jean K. Dudek, Raymond R. Mandra, Dominick A. Conde, Steven C. Bauman, Pasquale A. Razzano, John W. Behringer, Robert C. Kline, Mark J. Itri and William C. Hwang
Accorded Benefit:	None
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Junior Party

Applicants:	JACKSON B. HESTER, JR. 9219 East ML Avenue Galesburg, MI 49053 ROY A. JOHNSON 2122 Frederick Avenue Kalamazoo, MI 49008 ROBERT C. KELLY 936 East Gull Lake Drive Augusta, MI 49012 ELDON G. NIDY 3103 Morgan St. Kalamazoo, MI 49001 HARVEY L. SKULNICK 1745 Old Deer Run Kalamazoo, MI 49009
Application:	08/454,210, filed June 9, 1995
Title:	7-HALO- AND 7BETA-METHANO-TAXOLS, ANTINEOPLASTIC USE AND PHARMACEUTICAL COMPOSITIONS CONTAINING THEM
Assignee:	None
Attorneys:	Donald L. Corneglio, James D. Darnley, Jr., Martha A. Gammill, William G. Jameson, Bruce Stein, Lawrence T. Welch, Sidney B. Williams, Jr. and Thomas A. Wootton
Asso. Attorney:	None
Accorded Benefit:	07/990,579, filed December 15, 1992; 08/122,974, filed September 17, 1993; 08/013,826, filed February 2, 1993 and PCT US93/11827, filed December 13, 1993

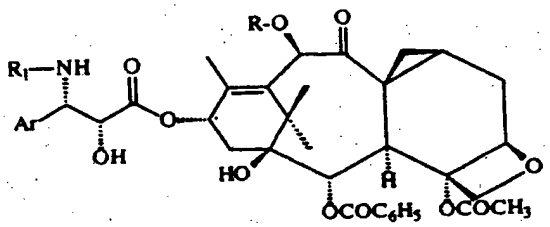
Address:	Corporate Intellectual Property Law The Upjohn Company Kalamazoo, MI 49001

Senior Party

Applicants:	HERVE BOUCHARD 114, avenue Danielle Casanova 942200 Ivry Sur Seine, France JEAN-DOMINQUE BOURZAT 36, boulevard de la Liberation 94300 Vincennes, France ALAIN COMMERCON 1, bis rue Charles Floquet Vitry-Sur-Seine, France
Application:	08/162,984, filed December 8, 1993
Title:	NEW TAXOIDS, THEIR PREPARATION AND PHARMACEUTICAL COMPOSITION CONTAINING THEM
Assignee:	None
Attorneys:	Thomas L. Irving, Bryan C. Diner, Martin F. Savitzky, Paul R. Darkes, James A. Nicholson, Rosanne Goodman, Ross J. Oehler, Raymond S. Parker, III and Julie K. Smith
Associates:	None
Accorded benefit:	France 92 14813, filed December 9, 1992
Address:	Thomas L. Irving Finnegan, Henderson, Farabow, Garrett & Dunner 1300 I Street, N.W. Washington, D.C. 20005-3315

COUNT 1

[Bouchard] A taxoid of the formula:



in which

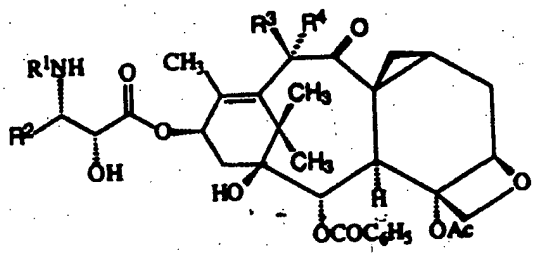
R represents hydrogen or acetyl,

R_1 represents benzoyl or R_2-O-CO- in which R_2 represents t-butyl, and

Ar represents phenyl or α- or β-naphthyl, said phenyl or naphthyl being unsubstituted or substituted by C_{1-4} alkyl, C_{1-4} alkoxy, halogen, or CF_3, or Ar represents 2- or 3-thienyl or 2- or 3-furyl, said thienyl or furyl being unsubstituted or substituted by halogen,

OR

[Chen] A compound of the formula



in which

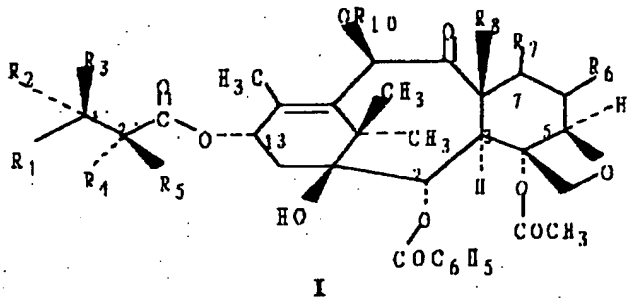
R^1 or $-COR^z$ in which R^z is t-butyloxy, C_{1-6} alkyl, C_{2-6} alkenyl, C_{2-6} alkynyl, C_{3-6} cycloalkyl, or phenyl, optionally substituted with one to three same or different C_{1-6} alkyl, C_{1-6} alkoxy, halogen or $-CF_3$ groups;

R^2 is C_{1-6} alkyl, C_{1-6} alkenyl, C_{2-6} alkynyl, C_{3-6} cycloalkyl, or a radical of the formula $-W-R^x$ in which W is a bond, C_{2-6} alkenediyl, or $-(CH_2)_t-$, in which t is one to six; and R^x is naphthyl, furyl, thienyl or phenyl, and furthermore R^x can be optionally substituted with one to three same or different C_{1-6} alkyl, C_{1-6} alkoxy, halogen or $-CF_3$ groups; and

R^3 is OCOR, -OCOOR, H, OH; R^4 is hydrogen; or R^3 and R^4 jointly form a carbonyl group; and R is C_{1-6} alkyl.

OR

[Hester] A compound of the Formula I:



I

wherein:

R_1 is selected from the group consisting of

$-CH_3$,

$-C_6H_6$ or phenyl substituted with one, 2 or 3 C_1-C_4 alkyl, C_1-C_3 alkoxy, halo, C_1-C_3 alkylthio, trifluoromethyl, C_2-C_6 dialkylamino, hydroxy or nitro, and

-2-furyl, 2-thienyl, 1-naphthyl, 2-naphthyl or 3,4-methylenedioxyphenyl;

R_2 is selected from the group consisting of -H, -NHC(O)H,-NHC(O)C_1-C_{10}alkyl, -NHC(O)phenyl, -NHC(O)phenyl substituted with one, 2 or 3 C_1-C_4 alkyl, C_1-C_3 alkoxy, halo, C_1-C_3 alkylthio, trifluoromethyl, C_2-C_6 dialkylamino, hydroxy or nitro, -NHC(O)C (CH_3)=$CHCH_3$, -NHC(O)$OC(CH_3)_3$, -NHC(O)OCH_2phenyl, -NH_2, -$NHSO_2$-4-methylphenyl, -NHC(O)$(CH_2)_3COOH$, -NHC(O)-4-(SO_3H)phenyl, -OH, -NHC(O)-1-adamantyl, -NHC(O)O-3-tetrahydrofuranyl, -NHC(O)O-4-tetrahydropyranyl -NHC(O)$CH_2C(CH_3)_3$, -NHC(O)$C(CH_3)_3$, -NHC(O)OC_1-C_{10}alkyl, -NHC(O)NHC_1-C_{10}alkyl, -NHC(O)NHPh, -NHC(O)NHPh substituted with one, 2 or 3 C_1-C_4 alkyl, C_1-C_3 alkoxy, halo, C_1-C_3 alkylthio, trifluoromethyl, C_2-C_6 dialkylamino, or nitro, -NHC(O)C_3-C_8cycloalkyl, -NHC(O)$C(CH_2CH_3)_2CH_3$, -NHC(O)$C(CH_3)_2$ CH_2Cl,-NHC(O)$C(CH_3)_2CH_2CH_3$, phthalimido, -NHC(O)-1-phenyl-1 -cyclopentyl, -NHC(O)-1-methyl-1-cyclohexyl, -NHC(S)$NHC(CH_3)_3$, -NHC(O)$NHC(CH_3)_3$ and -NHC(O)NHPh;

R_3 is selected from the group consisting of -H, NHC(O)phenyl and -NHC(O)$OC(CH_3)_3$, with the overall proviso that one of R_2 and R_3 is -H but R_2 and R_3 are not both -H;

R_4 is -H or selected from the group consisting of -OH, -OAc(-OC(O)CH_3), -OC(O)$OCH_2C(Cl)_3$, -$OCOCH_2CH_2NH_3^+$ $HCOO^-$, -NHC(O)phenyl, -NHC(O)$OC(CH_3)_3$, -$OCOCH_2$-CH_2COOH and pharmaceutically acceptable salts thereof, -$OCO(CH_2)_3COOH$ and pharmaceutically acceptable salts thereof, and -OC(O)-Z-C(O)-R' {where Z is ethylene (-CH_2CH_2-), propylene (-$CH_2CH_2CH_2$-), -CH=CH-, 1,2-cyclohexane or 1,2-phenylene, R' is -OH,-OH base, -$NR_2'R_3'$, -OR_3', -SR_3', -$OCH_2C(O)NR_4'$ R_5' where R_2' is -H or -CH_3, R_3', R_3' is $(CH_2)_nNR'_6R_7'$ or $(CH_2)_n$ $N^+R_6'R_7'R_8'$ X^- where n is 1-3, R_4' is -H or C_1-C_4alkyl, R_5' is -H, -C_1-C_4alkyl, benzyl, hydroxyethyl, -CH_2CO_2H or dimethylaminoethyl, R_6' and R_7' are -CH_3, -CH_2CH_3, benzyl or R_6' and R_7' together with the nitrogen of $NR_6'R_7'$ form a pyrrolidino, piperidino, morpholino, or N-methylpiperizino group; R_8' is -CH_3, -CH_2CH_3 or benzyl, X^- is halide, and base is NH_3, $(HOC_2H_4)_3N$, $N(CH_3)_3$, $CH_3N(C_2H_4)_2NH$, $NH_2(CH_2)_6NH_2$, N-methylglucamine, NaOH or KOH}, -OC(O)$(CH_2)_nNR^2R^3$ {where n is 1-3, R^2 is -H or -C_1-C_3alkyl and R^3 is -H or C_1-C_3alkyl}, -OC(O)CH(R")NH_2 {where R" is selected from the group consisting of -H, -CH_3, -$CH_2CH(CH_3)_2$, -$CH(CH_3)CH_2CH_3$, -$CH(CH_3)_2$, -CH_2phenyl, -$(CH_2)_4NH_2$, -CH_2CH_2COOH, -$(CH_2)_3NHC(=NH)NH_2$}, the residue of the amino acid proline, -OC(O)CH=CH_2, -C(O)$CH_2CH_2C(O)NHCH_2CH_2SO_3^-$ Y^+, -$OC(O)CH_2CH_2C(O)NHCH_2CH_2CH_2SO_3Y^+$ wherein Y^+ is Na^+ or $N^+(Bu)_4$, and -$OC(O)CH_2CH_2C(O)OCH_2$ CH_2OH;

R_5 is -H or -OH, with the overall proviso that when R_5 is -OH, R_4 is -H and with the further proviso that when R_5 is -H, R_4 is other than H;

R_6 is -H:-H when R_7 is α-R_{71}:β-R_{72} where one of R_{71} and R_{72} is -H and the other of R_{71} and R_{72} is -X where X is halo and R_8 is -CH_3; or

R_6 is -H:-H when R_7 is α-H:β-R_{74} where R_{74} and R_8 are taken together to form a cyclopropyl ring; and

R_{10} is -H or -C(O)CH_3; or

the pharmaceutically acceptable salt thereof when the compound contains either an acidic or basic functional group;

with the overall proviso that when R_{71} or R_{72} is fluoro, then R_2 is other than -NHC(O)phenyl or -NHC(O)C$(CH_3)_3$.

The claims of the parties corresponding to the count are:

Chen et al.: claims 1-6, 8 and 9

Hester et al.: claims 2, 3, 7, 19, 20, 34-37, 39-42 , 44 and 45.

Bouchard et al: claim 140

Count 2

4α-10β-diacetoxy-2α-benzoyloxy-5β,20-epoxy-1β-hydroxy-7β, 8β-methylene-9-oxo-19-nor-11-taxen-13α-yl(2R,3S)-3-tert-butoxycarbonylamino-2-hydroxy-3-phenylpropionate

OR

N-debenzoyl-N-t-butoxycarbonyl-7-deoxy-8-desmethyl-7,8-cyclopropataxol.

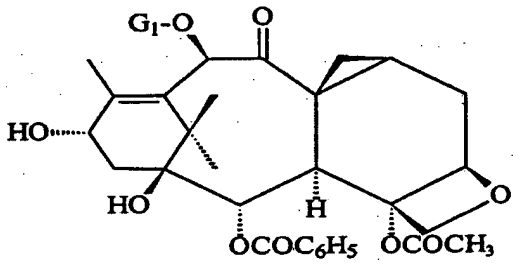
The claims of the parties corresponding to the count are:

Chen et al.: claims 7-9

Bouchard et al.: claim 142

Count 3A

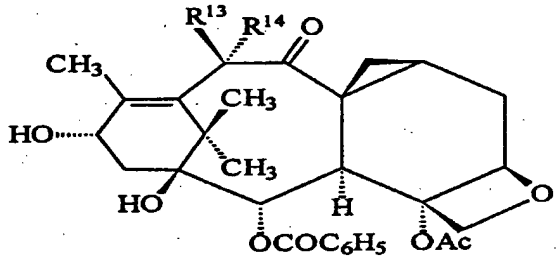
A taxoid of the formula:



in which G_1 represents hydrogen or acetyl,

OR

A compound of the formula:

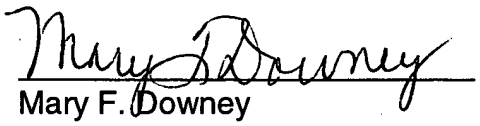


In which R^{13} is hydrogen, acetyloxy or hydroxy; R^{14} is hydrogen; or R^{13} and R^{14} jointly form a carbonyl group.

The claims of the parties corresponding to the count are:

Chen et al.: claims 10, 11

Bouchard et al. claim 141



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